

Application No. 10/821,202

REMARKS

Claims 1-78 and 80-82 are pending. By this Amendment, claim 77 is amended, and claims 79 and 83-85 are canceled without prejudice or disclaimer. Reconsideration of the rejections is requested in view of the arguments below.

Obviousness-type Double Patenting Rejections

In the Office Action, claims 1-85 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over:

Claims 1-41 of copending application no. 10/715,562;

Claims 1-23 of copending application no. 10/880,607;

Claims 1-21 of copending application no. 11/023,412;

Claims 1-19 of copending application no. 11/023,413; and

Claims 1-20 of copending application no. 11/034,255.

The explanation for each rejection is virtually identical and merely states that both articles contain coverings for use on an exterior surface [sic: and] are made with fibrous layers, moldable layers and release sheets covering the back surface of the moldable layer. The rejections are improper in that they do not consider the specific limitations of each claim and do not present a prima facie case of obviousness, as required.

An analysis employed in an obviousness-type double patenting rejection parallels the guidelines for analysis of a 35 U.S.C. §103 obviousness determination. *In re Braat*, 937 F.2d 589, 19 USPQ2d 1289 (Fed. Cir. 1991); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985). The following factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. §103 must also be employed when making an obvious-type double patenting analysis. These factual inquiries include:

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- (A) determining the scope and content of a patent (or application) claim relative to a claim in the application at issue;
- (B) determining the differences between the scope and content of the patent (or application) claim as determined in (A) and the claim in the application at issue;
- (C) determining the level of ordinary skill in the pertinent art; and
- (D) evaluating any objective indicia of nonobviousness.

The conclusion of obviousness-type double patenting is made in light of these factual determinations. Any obviousness-type double patenting rejection should make clear:

- (A) the differences between the inventions defined by the conflicting claims (i.e., a claim in the patent (or application) compared to a claim in the application); and
- (B) the reasons why a person of ordinary skill in the art would conclude that the invention defined in the claim at issue would have been an obvious variation of the invention defined in a claim in the patent.

None of these determinations have been made in the Office Action, and in particular the differences between the claims have not been identified. Therefore, the rejections are improper and should be withdrawn.

#### Prior Art Rejections

Claims 36-38, 47, 57-59, and 67 are rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 4,695,493 to Friedlander et al. (Friedlander).

According to the Office Action, Friedlander discloses an elongate composite strip comprising a layer of fibrous floor covering material (4, 6, 8), an adhesive layer (16), an impermeable foil layer barrier layer (12), an attachment layer (18), and a release paper (20) on the attachment layer. The Office Action states that the foil barrier layer has a thickness less than 0.001 inch, citing to col. 2, lines 45-48. However, this is incorrect as this passage in Friedlander refers to a shape retention web of a thickness *between about 1 to 100 mil*, which is greater than 1 mil. This range does not meet the claimed thickness of **less than 0.001 inch** (less than 1 mil.) This difference is significant because Friedlander's thickness allows the metal to retain a shape. As stated in col. 2, lines 34 – 44, Friedlander's assembly is capable of being formed into a stable three-dimensional contoured shape that will remain

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substantially unchanged in any of its three dimensions throughout storage and during its normal use. In distinction, the claimed invention uses a very thin foil so that the composite strip remains flexible, which is important during installation because the strip must be unrolled and steered along an irregular board for proper placement and adhesion. As each feature of claim 36 is not met by Friedlander, there can be no anticipation. Claim 36 is allowable.

Dependent claims 37, 38 and 47 are allowable for at least the above reasons and for the additional features recited therein. It is noted that claim 47 recites that the barrier layer is encapsulated between the adhesive layer and the attachment layer by an interconnection of the edges of the adhesive layer and the attachment layer at the edges of the barrier layer. The Office Action points to Fig. 1 and col. 3, lines 21 – 40, but this section does not describe encapsulation. In fact, the edges of the layers in Fig. 1 are clearly exposed, and thus not encapsulated. Further, col. 7, lines 8 – 15, describe how flat sections are cut from the carpet assembly and coldpressed into the three dimensional contour. Friedlander's carpet assembly does not have barrier layer that is encapsulated by an interconnection of the edges of the adhesive layer and the attachment layer as claimed.

Claim 57 recites that the barrier layer is flaccid, not that the thickness is less than 0.001 inch as asserted in the Office Action. Friedlander's shape retaining web is not flaccid, and therefore Friedlander does not anticipate claim 57. Claim 57 is allowable.

Dependent claims 58, 59, and 67 are allowable for at least the above reasons and for the additional features recited therein. Claim 59 states that the composite strip provides no resistance to bending and that it follows by gravity any undulations in the flat surface. The shape retaining web of Friedlander obviously resists bending and does not follow the shape of surface due to gravity or it would not retain its shape. Claim 67 recites that the barrier layer is encapsulated, similar to claim 47 discussed above, which is not disclosed by Friedlander.

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Claims 1-4, 9-15, 24-26, 41-46 and 61-66 are rejected under 35 U.S.C. §103(a) as being unpatentable over Friedlander in view of U.S. Patent No. 5,204,155 to Bell et al. (Bell).

The Office Action cites Friedlander as showing a carpet having an impermeable foil barrier layer secured to the back surface of the fibrous layer and a moldable layer covering the foil barrier layer. The foil layer is a shape retaining web having a thickness between 1-100 mils. Bell is added to teach of a moldable layer that is applied at a coating weight of between 185 and 600 gsm for the purpose of having a flooring that is sufficient to distribute compressive weight of objects placed on the face of the floor surface covering. It is asserted that it would have been obvious to provide such a moldable layer with such a coating weight in Friedlander to have a flooring that is sufficient to distribute the compressive weight of objects placed on the face of the flooring surface as taught by Bell.

Bell discloses a foam backed carpet having a series of layers between the carpet layer 14 and the bottom surface. In particular, Bell's carpet tile is formed of fabric 12 having a tufted face 14, a thin precoat layer 16 of rubber latex, a first layer 18 of bitumen containing glass fiber or scrim sheet material 20, a closed cell foam layer 22, a second bitumen layer 24 with tissue sheet material 26 therein, and a non-woven polyester or polypropylene backing layer 28 and no release sheet. (Col. 6, lines 6-27.) The bitumen layers are about 1300 g/m<sup>2</sup>. Bell is cited as allegedly teaching of using a moldable layer with a coating weight of greater than 185 gsm. However, Bell merely discloses using an intermediate bitumen layer in a foam backed carpet tile of 1300 g/m<sup>2</sup>.

The object of Bell is to address issues of compressive force in foam backed carpeting. The Office Action asserts that to provide a layer with such thickness in Friedlander would have been obvious to distribute the compressive weight of objects placed on the face of the flooring. It is unclear how the addition of a thick bitumen layer in Friedlander would be an

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advantage or where such a suggestion would originate. Further, Friedlander's carpet is used for contoured automobile panels, so there would be no motivation to distribute compressive weight. Moreover, Bell's design addresses issues relating to foam backed carpet, but Friedlander does not include a foam layer so it there would be no motivation to address such issues in Friedlander's design.

The combination of Friedlander and Bell would not result in a non-rigid composite covering strip, as claimed. Friedlander's carpet assembly is intended to retain different three dimensional shapes and thus is rigid. Bell's foam layered carpet assembly provides no suggestion to modify Friedlander to result in the claimed invention. Further, the combination is improper as there is no suggestion in the prior art for making the suggested modifications. It is noted that even if the suggested modifications could be properly made, all of the features of claim 1 would not be met by such a combination as explained above. Claim 1 is allowable.

Dependent claims 2-4, 9-15, and 24-26, which depend from claim 1, are also not rendered obvious by Friedlander in view of Bell for the reasons above and for the additional features recited therein. Note especially that claim 3 recites that the barrier layer is foil supported on plastic film, which was not addressed in the Office Action. Claim 4 recites that the barrier layer is encapsulated between the adhesive layer and moldable layer, which is not disclosed in Friedlander.

Claims 41 – 46, which depend from claim 36, and claims 61-66, which depend from claim 57, are allowable for at least the reasons noted above with respect to the deficiencies of Friedlander that are not remedied by Bell. Claims 46 and 66 additionally recite that the barrier layer is foil supported on plastic film, which has not been addressed or shown.

Claims 5-8 and 19 are rejected under 35 U.S.C. §103(a) as being unpatentable over Friedlander in view of U.S. Patent No. 6,426,129 to Kalwara et al. (Kalwara).

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While these claims depend from claim 1, which was rejected based on Friedlander modified by Bell, claims 5-8, and 19 are rejected only based on Friedlander and Kalwara, which is cited for teaching of a composite strip having a predetermined width less than 12 inches, a predetermined length at least 25 feet and a release sheet with free edges. It is asserted in the Office Action that it would have been obvious to have provided the claimed lengths and widths in Friedlander's covering in order to have a release liner that is easy to disengage from the tacky surface of the adhesive layer as taught by Kalwara.

Kalwara is directed to an adhesive rubber article for use in the roofing industry. There is no disclosure of moldable layer for a fibrous covering that is applied at a coating weight of at least about 185 gsm. Further there is no suggestion for modifying Friedlander's shape retaining web, which results in a rigid composite carpet assembly. As such, Kalwara does not remedy the deficiencies of Friedlander. Moreover, there is no suggestion in the prior art for why it would have been obvious for someone of ordinary skill in the floor covering art to look for roofing membranes for motivation to modify Friedlander's carpet panels. Absent proper motivation, a prima facie case of obviousness cannot be made. As such, claims 5-8 and 19 are not rendered obvious over Friedlander in view of Kalwara and are patentable.

Claims 16-18, 22, 23, 48-55, 68-71, 73-75, 77-80, and 82-84 are rejected under 35 U.S.C. §103(a) as being unpatentable over Friedlander in view of U.S. Patent No. 3,937,640 to Tajima et al. (Tajima).

Claims 16-18, 22, and 23 depend from claim 1, which was rejected based on Friedlander modified by Bell, but are only rejected based on a combination of Tajima and Friedlander. Tajima shows a laminated bituminous roofing membrane and is cited for teaching of a release sheet with a central release sheet. Tajima does not remedy the deficiencies of Friedlander noted above with respect to the non-rigid composite strip and does

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not teach of the claimed coating weight. So, at least these features are not met by the asserted combination of prior art. Further, there is no suggestion in the prior art to combine a bituminous roofing membrane with a automobile carpet piece. It is also noted that claim 18 recites that the middle release sheet overlaps the release strips on the edges, which is not disclosed or even suggested by Tajima. Claims 16-18, 22, and 23 should be allowed.

Claims 48-55 depend from claim 36 and are allowable for the reasons explained above that Friedlander fails to disclose a foil having a thickness of less than 0.001 inch since Tajima does not remedy this deficiency. Further, there is no suggestion in the prior art to make such a combination. It is additionally noted that claim 54 recites that the positioning strip release portion has two side edges each of which overlaps with and covers a side edge of a respective one of the remaining strip release portions, which is entirely absent from Tajima. Claims 68-71 and 73-75 depend from claim 57, which is also not anticipated by Friedlander as explained above. Tajima does not remedy the deficiency and moreover is not properly combinable with Friedlander. Again, claim 70 recites an overlap of the positioning strip edges, which is not disclosed or suggested by Tajima.

Independent claim 77 is directed to a composite elongate strip including a release sheet divided into a positioning strip release portion and a remaining strip release portion, wherein the positioning strip release portion has a side edge that overlaps with and covers a side edge of the remaining strip release portion so as to define a free side edge portion. As acknowledged in the Office Action, Friedlander's release paper does not have such portions. Tajima shows release portions 14 in FIG. 3B, but they are side by side and are formed by perforations or notches. Accordingly, there can be no overlap between the portions since they are formed in a single sheet. Friedlander's release paper modified by the teaching of Tajima therefore does not meet the features of claim 77. Moreover, there is no suggestion in the prior art that one of ordinary skill in the carpeting art would look to roofing membranes

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for a teaching. Thus, a prima facie case of obviousness based on a combination of Friedlander and Tajima has not been made. Claim 77 is allowable.

Dependent claims 78, 80 and 82 are allowable for at least the above reasons and for the additional features recited therein. In particular, claim 80 recites that the remaining strip release portion has an outer free edge that extends beyond the attachment layer. This is not shown by Friedlander or Tajima.

Claims 20, 21, 56, 72, 76, 81, and 85 are rejected under 35 U.S.C. §103(a) as being unpatentable over Friedlander in view of U.S. Patent No.4,849,267 to Ward et al. Claims 20 and 21 depend from claim 1, which was rejected based on Friedlander modified by Bell, through claim 19, which was rejected based on Friedlander modified by Kalwara. Claims 56, 72, 76, and 81 depend from base claims rejected based on Friedlander modified by Tajima. However, the above claims are only rejected by Friedlander modified by Ward.

Ward shows arrows printed on the secondary backing 14 that are visible through the transparent release cover. The release cover does not extend past the edges of the carpet pieces. Ward does not provide the teachings attributed in the Office Action to Bell and Tajima and therefore the combination of Friedlander and Ward lack the elements of the base claims. Further, Ward merely teaches of printing indicia on the carpet backing. Claims 20, 56, 72, 76, and 81 recite that the free edges of the release sheet that extend beyond the fibrous layer and moldable layer have indicia. Ward shows indicia on the carpet backing, not the release sheet, and has no free edges. Thus, the asserted combination does not meet the features of the claims. Claims 20, 21, 56, 72, 76, and 81 are allowable.

Claims 27-29, 31, 32, 39, 40, and 60 are rejected under 35 U.S.C. §103(a) as being unpatentable over Friedlander in view of U.S. Patent No. 5,475,952 to O'Connor.

Again, claim 27 depends from claim 1, which was rejected based on Friedlander modified by Bell, yet claim 27 is only rejected by Friedlander modified by O'Connor.



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O'Connor does not provide the teachings attributed in the Office Action to Bell and therefore the combination of Friedlander and O'Connor lacks the elements of the base claim. Claim 27 is allowable for at least this reason and for the additional features recited therein.

O'Connor is cited as teaching of a treated lumber covering applied to the surface of a board that protects the users from the possibility of splinters. It is asserted in the Office Action that it would have been obvious to have provided the treated lumber covering using the material of Friedlander in order to have a covering on a treated lumber surface that protects the users from the possibility of splinters as taught by O'Connor.

Claim 28 is directed to a treated lumber covering comprising an elongated carpet strip with a back surface having a flaccid foil laminated thereto and a thick adhesive layer applied to the foil that forms a moldable surface with an adhesive tack for permanent attachment to the treated lumber that creates a dermal barrier. Neither Friedlander nor O'Connor teaches of a flaccid foil. Friedlander's foil is shape retaining, and O'Connor's support layer is formed of extruded plastics with ribs 30A. O'Connor's support layer is formed to provide structural strength so that the strip remains arched. There is simply no teaching in either reference of a flaccid foil as claimed. Claim 28 is not rendered obvious by Friedlander as modified by O'Connor and is allowable.

Dependent claims 29, 31, and 32 are allowable for at least the above reasons and for the additional features recited therein. Claims 39 and 40 depend from claim 36 and are allowable for at least the above reasons with respect to claim 36 as O'Connor does not remedy the deficiencies of Friedlander with respect to claim 36. Claim 60 depends from claim 57 and is allowable for at least the above reasons with respect to claim 57 as O'Connor does not remedy the deficiencies of Friedlander with respect to claim 57.

Claim 30 is rejected under 35 U.S.C. §103(a) as being unpatentable over Friedlander in view of O'Connor as applied to claim 28 and further in view of Bell.

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Bell is cited to teach of the coating weight, but does not remedy the deficiencies of the Friedlander and O'Connor combination. Claim 30 is not rendered obvious by the asserted combination and is allowable.

Claim 33 is rejected under 35 U.S.C. §103(a) as being unpatentable over Friedlander in view of O'Connor as applied to claim 28 and further in view of Tajima.

Tajima is cited as teaching of a central release sheet portion, but does not remedy the deficiencies of the Friedlander and O'Connor combination. Claim 33 is not rendered obvious by the asserted combination and is allowable.

Claims 34 and 35 are rejected under 35 U.S.C. §103(a) as being unpatentable over Friedlander in view of O'Connor as applied to claim 28 and further in view of Ward.

Ward is cited as teaching of indicia, but does not remedy the deficiencies of the Friedlander and O'Connor combination. Further, Ward does not teach of indicia on release sheets. Claims 34 and 35 are not rendered obvious by the asserted combination and are allowable.

It is respectfully submitted that the claims are allowable and that the application is in condition for allowance. A prompt notice to that effect is respectfully requested. Should further issues require resolution prior to allowance, the Examiner is requested to telephone the undersigned.

Respectfully submitted,



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